

Remarks

This application has been reviewed in light of the Office Action of April 26, 2005. Claims 1-13 are pending, and all claims are rejected. In response, claims 5 and 12 are amended; new claims 14-16 are added; and the following remarks are submitted. Reconsideration of this application, as amended, is requested.

Claims 1-10 and 12 are rejected under 35 USC 103 over Milaniak US 5,366,765 in view of Rafferty US 5,334,417. Applicant traverses this ground of rejection.

The following principle of law applies to all sec. 103 rejections. MPEP 2143.03 provides "To establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." [emphasis added] That is, to have any expectation of rejecting the claims over a single reference or a combination of references, each limitation must be taught somewhere in the applied prior art. If limitations are not found in any of the applied prior art, the rejection cannot stand. In this case, the applied prior art references clearly do not arguably teach some limitations of the claims.

Claim 1 recites in part:

"placing an aluminide coating tape into the hollow interior through the access opening; and

vapor phase aluminiding the hollow article using an external aluminum vapor source separate from the aluminide coating tape". [emphasis added]

Claim 12 has a similar recitation.

Applicant agrees that Milaniak teaches placing an aluminum-source slurry into the hollow interior of the article, see col. 2, lines 29-46. However, Milaniak does not teach "vapor phase aluminiding" using an external aluminum vapor source separate from the aluminide coating tape, as recited in claim 1. At col. 6, lines 10-16, Milaniak teaches using a diffusion powder pack, not vapor-phase aluminiding, as described in para. [0024] of the present Specification. Many other sources describe vapor-phase aluminiding and the

distinction with powder pack aluminiding, for example see US Patents 6,881,439 and 6,883,927, and clearly distinguish vapor-phase aluminiding from the approach described in Milaniak.

Rafferty teaches using a coating tape, but does not teach "vapor phase aluminiding". Thus, neither of the references teaches this claim limitation.

The present rejection seeks to perform a hindsight reconstruction based upon unrelated references, which is technically unsupported and is legally improper.

The case authority and the MPEP provide guidance on this point. The present rejection is a sec. 103 combination rejection. It is well established that a proper sec. 103 combination rejection requires more than just finding teachings in the references of the elements recited in the claim (but which was not done here). To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2143 and 2143.01. See also, for example, In re Fine, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed.Cir. 1988), In re Laskowski, 10 USPQ2d 1397, 1398 (Fed.Cir. 1989), W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311-313 (Fed. Cir., 1983), and Ex parte Levengood, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993); Ex parte Chicago Rawhide Manufacturing Co., 223 USPQ 351 (Board of Appeals 1984). As stated in In re Fine at 5 USPQ2d 1598:

"The PTO has the burden under section 103 to establish a prima facie case of obviousness. [citation omitted] It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

And, at 5 USPQ2d 1600:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Following this authority, the MPEP states that the examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

-7-

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).”

* * * * *

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).”

* * * * *

“A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levensgood, 28 USPQ2d 1300 (Bd.Pat.App. & Inter. 1993).”

Here, there is set forth no objective basis for combining the teachings of the references in the manner used by this rejection, and selecting the helpful portions from each reference while ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure. Applicant respectfully suggests that the rationales, urged in the explanation of the rejection in the paragraph bridging pages 3-4 of the Office Action, are all hindsight reconstructions, not objective bases. The “expectation of similar results” is not supported in the art references, because Rafferty does not teach aluminiding the interior of a hollow article and does not teach that his approach would accomplish similar results to the slurry approach of Milaniak. The “expectation of simplifying the overall coating process” is also without a factual basis in the art, because one could not insert a coating tape into the “convoluted internal cooling passage” described by Milaniak (col. 5, lines 44-45). There would be no expectation of success for the same reason. Milaniak uses a slurry so that it can flow and convey aluminiding source material into the convoluted internal cooling

passages of his blade, and a tape could not be inserted into such convoluted internal cooling passages. None of these three rationales are found in the prior art references themselves or were generally known to those in the art.

If the rejection is maintained, Applicant asks that the Examiner set forth the objective basis found in the references themselves for combining the teachings of the references, and for adopting only the helpful teachings of each reference and disregarding the unhelpful teachings of the reference.

Applicant agrees that neither reference teaches the limitations of claim 2. The conditions for new-make and refurbishment are different, see para. [0026] of the present Specification. Milaniak teaches placing aluminum source powders into the interior of the hollow blade by a slurry process in order to convey the source powders throughout the convoluted internal cooling passages and packs the exterior of the blade in aluminum source powder. The required processing is different for the powder approach of Milaniak, the approach of Rafferty, and the present approach.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

Claim 11 is rejected under 35 USC 103 over Milaniak in view of Rafferty, and further in view of Baldi US 3,958,047. Applicant traverses this ground of rejection.

Claim 11 depends from claim 1 and incorporates its limitations. The combination of Milaniak and Rafferty does not teach the limitations of claim 1 for the reasons discussed above, and which are incorporated here. Baldi adds nothing in this regard.

Baldi teaches a pack aluminizing approach in which the article to be coated is immersed in a mass of source particles, not vapor phase aluminizing in which the article to be coated is physically separated from the solid aluminum source.

CONCLUSION

In view of the above, Applicant respectfully requests reconsideration of the Application and withdrawal of the outstanding objections and rejections. As a result of the amendments and remarks presented herein, Applicant respectfully submits that claims are not anticipated by nor rendered obvious by the cited art either alone or in combination and thus, are in condition for allowance. As the claims are not anticipated by nor rendered obvious in view of the applied art, Applicant requests allowance of all of the remaining claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant.

This Response has been filed within three (3) months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicants are mistaken in their calculations, the Commissioner is hereby authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Applicant respectfully requests entry of the above amendment and allowance of the claims.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Dated: May 12, 2005

Respectfully submitted,

McNees Wallace & Nurick LLC



K. Scott O'Brian
Reg. No. 42,946
100 Pine Street
P.O. Box 1166
Harrisburg, PA 17108-1166

Phone: (717) 237-5492
Fax: (717) 237-5300